

REMARKS

Reconsideration and allowance of the subject application are respectfully requested.

The Examiner raises a question about the priority claim suggesting that the specification does not include a reference to the earlier provisional application. The Examiner's attention is directed to the cover sheet filed on March 8, 2002, along with the application and the preliminary amendment, which specifically checked a box instructing the PTO to amend the specification by inserting text making specific reference to the priority provisional application. Withdrawal of the objection regarding the priority and acknowledgement of the priority claim is respectfully requested.

All claims 1-20 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent 6,708,031 to Purnadi in view of U.S. Patent 6,456,839 to Chow. This rejection is respectfully traversed.

Purnadi describes a new session or handoff procedure where the mobile terminal may visit another network other than its home network. Purnadi wants subscribers to be able to roam between cellular networks and preferably access the same services available in the home network when they are visiting other networks. Purnadi fails to disclose any teaching that a network is shared between different owners.

The independent claims specifically recite "determining which one of the owners of a shared radio network that a visiting MT (Mobile Terminal), which MT is not subscribed to any of the owners of said shared radio network, is going to be connected to." Nor is there any teaching in Purnadi of using derived visiting mobile terminal identification information "in said shared radio network for determining which one of said shared radio network owners said visiting MT is going to be connected to." A shared radio network owner is not the same thing as

a visiting network or a home network. As explained in the background of the instant application, 3G radio networks are quite expensive. One way to decrease the costs is for two or more 3G operators to established a shared 3G radio network. There is no teaching that Purnadi's UTRAN 103 is a radio network shared by two or more network operators.

The Examiner admits that Purnadi does not disclose "determining which one of said owners said visiting MT is going to be connected based on the derived information," and relies on the Chow patent. Chow discloses the method for billing a neighborhood cordless service. A local cordless service provides a mobile wireless subscriber loop to allow a subscriber to disconnect their wired telephone service provided by their incumbent local exchange carrier. The local cordless service network defines a plurality of neighborhood zones, including a home neighborhood zone and a visiting neighborhood zone from the perspective of the individual subscriber. The local cordless service is different from a current cellular service in that the local cordless radio equipment interfaces to a digital line switch and not a mobile switching center. An objective of Chow is to permit the mobile subscriber, when roaming from one zone to another zone, to continue the call interrupted without paying air time charges. The same is true as the user moves into a cellular environment while participating in an active call.

The Examiner refers to column 16, lines 44 through column 17, line 6 of Chow, which simply describes a registration of a mobile station in a visiting network zone. Like Purnadi, Chow fails to disclose that the visiting network referred to by the Examiner is shared by different owners. In the independent claims, it is not simply a matter of determining whether a mobile terminal is permitted to roam to a particular visiting network. Rather, the independent claims acknowledge that an additional decision making process is needed when a network is shared by two or more owners. Namely, it must be determined which one of the owners of the shared

network that a visiting mobile terminal, which is not a subscriber with any of the owners of the shared radio network, is going to be connected to.

Thus, even if the combination of Purnadi and Chow could be made for purposes of argument only, that combination fails to disclose the features related to shared network owners.

The combination of Purnadi and Chow is also improperly based on hindsight. To prevent the use of hindsight, the Federal Circuit requires the Examiner to show a motivation to combine the references. Specifically, the Federal Circuit has stated:

the Examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). As is readily apparent, neither Purnadi nor Chow acknowledge that shared networks even exist, let alone the problems that confront the owners of such shared networks when a visiting mobile terminal, which is not a subscriber with any of the owners of the shared network, requires service from the shared network.

Lacking the combination of features recited in the independent claim and a proper motivation to combine the references, Applicants respectfully submit that the application is in condition for allowance. An early notice to that effect is earnestly solicited.

STILLE et al.
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Respectfully submitted,

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By:

A handwritten signature in black ink, appearing to read 'John R. Lastova', is written over a horizontal line.

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